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JERRY.SHORMA@HP.COM
ipa.mail@hp.com
jessica.l.fusek@hp.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ELLIOT L. KLOSTERMAN, JAMES DUBOIS,
JAMES A. HEWITT, and DENNIS W. HOWARD

Appeal 2008-6082
Application 09/943,239
Technology Center 2600

Decided:¹ April 20, 2009

Before JOSEPH F. RUGGIERO, MAHSID D. SAADAT, and ROBERT E. NAPPI, *Administrative Patent Judges*.

RUGGIERO, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for response or filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from the Examiner's rejection of claims 1, 5-16, and 18-20. Claims 2-4 and 17 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse and also enter a new ground of rejection pursuant to 37 C.F.R. § 41.50(b).

Rather than repeat the arguments of Appellants or the Examiner, we refer to the Appeal Brief filed on July 2, 2007, the Examiner's Answer mailed on October 17, 2007, and the Reply Brief filed on December 17, 2007. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived (*see* 37 C.F.R. § 41.37(c)(1)(vii)).

Appellants' Invention

The invention claimed on appeal relates to an interface module which mediates between a printer driver and an add-on module permitting the printer driver to call the add-on module utilizing the interface module. In particular, in response to a call from the printer driver indicating the initiation of a print job, the add-on module is connected to the printer driver. (*See generally* Spec. 5:20 to 6:3, 13:19-22).

Claim 1 is illustrative of the invention and is reproduced as follows:

1. A method for processing a print stream through a printer driver, comprising:

 providing an interface module that interfaces with the printer driver;

 registering at least one add-on module with said interface module, said registering comprising receiving property

information at said interface module from each said add-on module and storing said property information;

receiving a call from the printer driver indicating that a print job is initiated;

determining whether any of said add-on modules are responsive to said call; and

in response to determining that at least one add-on module is responsive, connecting said at least one responsive add-on module to the printer driver via said interface module.

The Examiner's Rejection

The Examiner relies on the following prior art reference to show unpatentability:

Howard US 6,823,526 B2 Nov. 23, 2004

The Final Rejection mailed on March 5, 2007 sets forth a rejection of claims 1, 5-16, and 18-20 on appeal as being anticipated under 35 U.S.C. § 102(e) by Howard.

ISSUE

Under 35 U.S.C. § 102(e), does Howard have a disclosure which anticipates the invention set forth in claims 1, 5-16, and 18-20?

The pivotal issue before us in making this determination is whether Appellants have demonstrated that the Examiner erred in determining that Howard discloses the connection of an add-on module to a printer driver in response to the initiation of a print job.

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence:

1. Howard discloses (col. 2, ll. 10-18; col. 6, ll. 4-16) that computer systems with external devices such as printers may be configured to include optional “add-on” features such as envelope feeders, input and output trays, etc.

2. Howard further discloses (col. 6, ll. 17-36) that the engine code element 35 searches the device hardware 38 for add-on features which are included in a specific external device, such as a printer, for connection to a host computer 20.

3. Howard also discloses (col. 9, ll. 43-51) that, upon installation of the device driver, such as the printer driver 26, in the operating system of the host computer, the host computer will operate to execute applications by searching for the identifier key 23 of the add-on module 43 in the registry 24.

PRINCIPLES OF LAW

It is well settled that in order for the Examiner to establish a *prima facie* case of anticipation, each and every element of the claimed invention, arranged as required by the claim, must be found in a single prior art reference, either expressly or under the principles of inherency. *See generally In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997); *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 678-79 (Fed. Cir. 1988); *Lindemann Maschinenfabrik GMBH v. Am. Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984). “Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Continental Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264, 1268-69

(Fed. Cir. 1991) (quoting *Hansgirg v. Kemmer*, 102 F.2d 212, 214 (CCPA 1939)) (emphasis omitted). The reference must teach each and every claim limitation, it must be enabling, and it must describe the claimed subject matter sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention. *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339, 1346 (Fed. Cir. 2000); *In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994).

ANALYSIS

Appellants' arguments in response to the Examiner's anticipation rejection, based on Howard, of independent claims 1 and 16 assert that the Examiner has not shown how each of the claimed features is present in the disclosure of Howard so as to establish a *prima facie* case of anticipation. Appellants' arguments (App. Br. 4-5; Reply Br. 1-2) focus on the contention that, in contrast to the requirements of appealed independent claims 1 and 16, Howard does not disclose that the add-on modules (optional features components 43) are called or implemented in response to the initiation of a print job. According to Appellants (App. Br. 4-5; Reply Br. 1-2), while Howard does disclose (col. 3, ll. 22-24) that the driver configuration component is modified in accordance with the identifier key associated with the optional features components, there is no indication in the disclosure of Howard that the optional features components are connected to the printer driver in response to the initiation of a print job.

We agree with Appellants. While Howard does indeed disclose the connection of an add-on feature component 43 to the printer driver 26, this connection operation is at best suggested by Howard (col. 9, ll. 43-64) as

taking place during installation of the printer driver, not in response to the initiation of a print job.

The Examiner's stated position recognizes that Howard's disclosure does not explicitly state and is, at best, unclear as to the timing of when the add-on modules are connected to the printer driver. The Examiner, nonetheless, finds (Ans. 3, 7, 8) that, since Howard (col. 9, ll. 43-52) discloses that when print job instructions are executed by the printer driver the printer drive searches for the identifier key 23 of the add-on module 43 in registry 24, this would inherently suggest that the add-on module 43 would be appended to the printer driver at that time.

It is our finding, however, that even if we accept, *arguendo*, the Examiner's position that Howard's printer driver searches for the identifier key of the add-on module in response to the initiation of a print job, it does not *necessarily* follow that the add-on module would be connected to the printer driver at that time. To the contrary, as previously discussed, the disclosure of Howard suggests that the connection of the add-on module 43 to printer driver 26 takes place during installation of the printer driver. It is also important to note that the claims call for the connection of the add-on module to the printer driver in response to the initiation of a print job, not just the configuring of the driver upon identification of the appropriate add-on modules, as suggested by the Examiner.

To establish inherency, evidence must make clear that the missing descriptive matter is *necessarily* present in the thing described in the reference and would be recognized as such by persons of ordinary skill. *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (citing *Continental*, 948 F.2d at 1268). "Inherency, however, may not be established by probabilities

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or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Continental*, 948 F.2d at 1269 (citation omitted) (emphasis omitted).

In view of the above discussion, since Appellants’ arguments have demonstrated that the Examiner erred in determining that all of the claim limitations are present in the disclosure of Howard, we do not sustain the Examiner’s 35 U.S.C. § 102(e) rejection of appealed independent claims 1 and 16, nor of claims 5-15 and 18-20, dependent thereon.

CONCLUSION

Based on the findings of facts and analysis above, we conclude that Appellants have shown that the Examiner erred in rejecting claims 1, 5-16, and 18-20 for anticipation under 35 U.S.C. § 102(e).

REJECTION UNDER 37 C.F.R. § 41.50(b)

Claims 16 and 18-20 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter since they do not fall within any of the four categories of invention set forth in the statute, i.e., process, machine, manufacture, or composition of matter. These claims recite a “computer program product” data structure including a series of “instructions” for performing a series of functions. There is no claim language, however, which defines any structural and functional interrelationship between the data structure and a computer’s software and hardware components which permit the data structure to be realized. As such, the claims are directed to non-statutory functional descriptive material *per se* because they are not

capable of causing functional change in the computer. *See In re Warmerdam*, 33 F.3d 1354, 1360 (Fed. Cir. 1994).

We recognize that the preamble of independent claim 16 includes language directed to an information handling system with computer system components such as an operating system environment, a printer driver, and an interface module. The claimed computer program product, however, is specifically recited as being merely intended “for use” in such an information handling system. It is well settled that if the body of a claim merely sets forth the purpose or intended use of the invention, rather than any distinct definition of the claimed invention’s limitations, the preamble is not considered a limitation and is of no patentable significance. *See Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999).

DECISION

The Examiner’s decision rejecting claims 1, 5-16, and 18-20 under 35 U.S.C. § 102(e) is reversed. A new rejection of claims 16 and 18-20 under 35 U.S.C. § 101 is entered pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides: “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the

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examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

REVERSED
37 C.F.R. § 41.50(b)

babc

HEWLETT PACKARD COMPANY
P. O. BOX 272400, 3404 E. HARMONY ROAD
INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS, CO 80527-2400